UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/094,395	09/08/87	DRORI	Z

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EXAMINER	
RELDON, G	
ART UNIT	**PAPER NUMBER**
264	14

DATE MAILED: 04/14/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on Jan. 30, 1989 ☑ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 29-33, 35, 37-43, 53-63 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1-28, 34, 36, 44-52 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☑ Claims 29-33, 35, 37-43, 53-63 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

1. The text of those sections of Title 35 U. S. Code not included in this action can be found in a prior Office action.

2. Claims 29-33, 35, 37-43, and 53-63 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-34 of copending application Serial No. 277959.

This is a **provisional** double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 29-33, 35, 37-43, and 53-63 are of this application conflict with claims 1-34 of application Serial Number 277959. 37 CFR 1.78(b) provides that where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP 822.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how

to make and/or use the invention.

Please note paragraphs 3-6 of the previous Office action which is hereby incorporated into this action.

As set forth in MPEP 608.01(p), "an application as filed must be complete in itself in order to comply with 35 USC 112". On pages 12-15 of applicant's response filed January 30, 1989, there are arguments directed to structure which would support functions set forth in the original specification and drawings. However, none of the structures or programs are in the original disclosure.

The description of the elements and programs in issue in the original disclosure and their interaction in the system can, in general, only be described as conceptual. As indicated in In re Knowlton, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973), the invention claimed must be described somewhere in the specification. Otherwise, it is left to the artisan to try to find out for himself precisely what is intended or will work to effect the suggested operations.

As indicated in In re Scarbrough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974), the statute requires the application itself to inform, not direct others to find out for themselves.

The CCPA (In re Prater and Wei; 162 USPQ 541) held, "Apparatus and process claims broad enough to encompass operation of programmed general-purpose digital computer are not necessarily unpatentable; once a program has been introduced." Applicant's microprocessor with a

memory is a digital computer. Therefore, its functions can only be supported by a disclosed program. Such a program was not in the originally filed disclosure.

5. Claims 29-33, 35, 37-43, and 53-61 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the above objection to the specification.

6. Claims 29-33, 35, 37-43, and 53-61 are rejected under 35 U.S.C. 103 as being unpatentable over Pinnow in view of Tolson and Aydin.

Pinnow teaches an electronically programmable remote control vehicle (column 4, lines 43-47) security (e.g. locking) system comprising a portable hand-held (e.g. pencil watch. See column 3, line 6) transmitter comprising means (column 2, line 55) for generating and transmitting a predetermined digitally encoded receiver signal or signals (column 3, lines 14-16), actuating means 24 for actuating said generating and transmitting means (column 3, lines 35-40 suggest plural key or transmitting means) so that said signal or signals are automatically generated and transmitted; a system control unit to obviously be disposed within said vehicle comprising receiving means 48 operable during a system program mode and a system operating-receiving mode for receiving said transmitted encoded signal and generating an electrical signal representative of the encoded signal by amplifier 50; a digital memory (column 9, lines 17-25) for storing data representative of control signal; programming and operating means 52. Pinnow does not teach a radio frequency system.

At the time that the invention was made, Tolson (column 3, lines 53-62) had disclosed the interchangeability of a light and radio system. One of ordinary skill in the art having Tolson would readily find obvious that the teaching in Tolson could be used to substitute a radio signal for a light signal in Pinnow.

In column 2, lines 50-54, Pinnow points out that his invention can be used to replace a card. Aydin (column 98, lines 30-32) teaches a predetermined time delay means which can be used in a programmable security system. Since Pinnow's invention can be substituted for a card in Aydin, the teaching in Aydin can obviously be used in Pinnow because their teachings are interchangeable.

7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE **THREE MONTHS** FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. Weldon whose telephone number is (703)

557-3357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3321.

U. Weldon:klw

4-12-89

(703) 557-3357

Ulysses Weldon

ULYSSES WELDON
PRIMARY EXAMINER
GROUP 260